

This Opinion is Not a
Precedent of the TTAB

Mailed: February 9, 2023

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re Deborah J. Whitcas
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Serial No. 90117114
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Gene Bolmarcich of Law Offices of Gene Bolmarcich,
for Deborah J. Whitcas.

Candace W. Hays, Trademark Examining Attorney, Law Office 110,
Chris Pedersen, Managing Attorney.

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Before Cataldo, Goodman and Hudis,
Administrative Trademark Judges.

Opinion by Hudis, Administrative Trademark Judge:

Deborah J. Whitcas (“Applicant”) seeks registration on the Principal Register of the standard character mark TOUCHDOWN TIMEOUT for “[e]ntertainment services, namely, ongoing digital television show dealing with sports” in International Class 41.¹

The Trademark Examining Attorney refused registration under Trademark Act Section 2(d), 15 U.S.C. § 1052(d), on the ground that Applicant’s mark, as applied to

¹ Application Serial No. 90117114 was filed on August 16, 2020 under Trademark Act Section 1(a), 15 U.S.C. § 1051(a), based upon Applicant’s claim of first use of the mark anywhere and first use in commerce since at least as early as June 1, 2020.

the services identified in the Application, so resembles the standard character mark TIME OUT, registered on the Principal Register for “organising, producing and conducting events, music events, comedy events, entertainment, competitions, contests, festivals, carnivals, pageants, displays, shows, fashion shows, exhibitions, film screenings, programmes and performances and radio and TV broadcasts and programmes and performances; production of films, recordings ...,” in International Class 41,² as to be likely to cause confusion, mistake, or deception.

After the Trademark Examining Attorney made the refusal final, Applicant appealed to this Board. Applicant and the Examining Attorney filed briefs.³ We affirm the refusal to register.

I. Likelihood of Confusion: Applicable Law and Analysis

Trademark Act Section 2(d) prohibits the registration of a mark that:

[c]onsists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive.

² Registration No. 5766646 was issued on June 4, 2019. The Registration recites other services in Class 41, as well as other goods and services in Classes 9, 35, 38, 39, 42, 43 and 45. The only identified services on which the Examining Attorney relies for the refusal register are those quoted above in the main text. The other identified goods and services are not part of this appeal.

³ Page references herein to the application record refer to the online database of the USPTO’s Trademark Status & Document Retrieval (“TSDR”) system. All citations to documents contained in the TSDR database are to the downloadable .pdf versions of the documents. References to the briefs on appeal refer to the Board’s TTABVue docket system. Before the TTABVue designation is the docket entry number; and after this designation are the page references, if applicable.

Our analysis is based on all of the probative evidence of record. *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (“*DuPont*” – noting the factors to be considered). In making our determination, we consider each *DuPont* factor for which there is evidence and argument. *See In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162-63 (Fed. Cir. 2019). Varying weights may be assigned to each *DuPont* factor depending on the evidence presented. *See Citigroup Inc. v. Cap. City Bank Grp., Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1261 (Fed. Cir. 2011); *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1688 (Fed. Cir. 1993) (“[T]he various evidentiary factors may play more or less weighty roles in any particular determination.”).

In applying the *DuPont* factors, we bear in mind the fundamental purposes underlying Trademark Act Section 2(d), which are to prevent confusion as to source and to protect trademark owners from damage caused by the registration of similar marks for related goods or services that are likely to cause confusion. *Park ‘N Fly, Inc. v. Dollar Park & Fly, Inc.*, 469 U.S. 189, 224 USPQ 327, 331 (1985); *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 34 USPQ2d 1161, 1163 (1995); *DuPont*, 177 USPQ at 566.

In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) (“The fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.”). We

discuss below these factors, and the other *DuPont* factors for which there is evidence and argument.

A. The Similarity or Dissimilarity of the Respective Services, Channels of Trade and Potential Consumers

1. Services

We now turn to the comparison of the services at issue, the second *DuPont* factor. In making our determination regarding the similarity of the services, we must look to the services as identified in the appealed TOUCHDOWN TIMEOUT Application and the cited TIME OUT Registration. *See Stone Lion Cap. Partners, LP v. Lion Cap. LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1162 (Fed. Cir. 2014) (quoting *Octocom Sys., Inc. v. Hous. Comput. Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990) (“[T]he question of registrability of an applicant’s mark must be decided on the basis of the identification of ... [services] set forth in the application regardless of what the record may reveal as to the particular nature of an applicant’s ... [services], the particular channels of trade or the class of purchasers to which the sales of ... [services] are directed.”)); *see also Paula Payne Prods. Co. v. Johnson Publ’g Co.*, 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973) (“Trademark cases involving the issue of likelihood of confusion must be decided on the basis of the respective descriptions of ... [services]”).

“It is sufficient that the respective services are related in some manner, and/or that the conditions and activities surrounding the marketing of the ... [services] are such that they would or could be encountered by the same persons under circumstances that could, because of the similarity of the marks, give rise to the

mistaken belief that they originate from the same producer.” *In re Jump Designs LLC*, 80 USPQ2d 1370, 1374 (TTAB 2006).

The cited TIME OUT registration uses broad wording to describe the identified services, namely, “organising, producing and conducting ... TV broadcasts and programmes and performances,” which presumably encompasses all services of the type described in the TOUCHDOWN TIMEOUT Application, including, “ongoing digital television show dealing with sports.” *See In re Solid State Design Inc.*, 125 USPQ2d 1409, 1413 (TTAB 2018). Thus, Applicant’s and Registrant’s services are legally identical. *See In re i.am.symbolic, llc*, 127 USPQ2d 1627, 1629 (TTAB 2018) (citing *Tuxedo Monopoly, Inc. v. Gen. Mills Fun Grp., Inc.*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981)).

Relatedness of the services can be found based on the descriptions in the Application and Registration without resort to additional evidence. *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002) (“While additional evidence, such as whether a single company sells the ... services of both parties, if presented, is relevant to a relatedness analysis ..., the important evidence already before [the Board comprises the identifications of services in] the ... application and [cited] registration[]”).

The Examining Attorney argues that the Class 41 services of the TOUCHDOWN TIMEOUT Application are identical or related to the Class 41 services of the TIME OUT registration.⁴ Applicant, in its appeal brief, does not argue to the contrary.⁵

We find the respective services are identical in part, and otherwise related. The second *DuPont* factor supports a finding that confusion is likely.

2. Trade Channels and Potential Consumers

The third *DuPont* factor considers “the similarity or dissimilarity of established, likely-to-continue trade channels.” *In re Detroit Athletic Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1051 (Fed. Cir. 2018) (quoting *DuPont*, 177 USPQ at 567). Because Applicant’s services overlap with the identified services of the cited TIME OUT registration, we must therefore presume that the channels of trade and potential consumers are also identical as to these overlapping goods. *See In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (finding Board entitled to rely on this legal presumption in determining likelihood of confusion); *In re Yawata Iron & Steel Co.*, 403 F.2d 752, 159 USPQ 721, 723 (CCPA 1968) (where there are legally identical goods, the channels of trade and classes of purchasers are considered to be the same). Applicant, in its appeal brief, does not argue against the overlap of trade

⁴ Examining Attorney’s Brief, 6 TTABVUE 4.

⁵ In fact, in Applicant’s Response to one of the Examining Attorney’s Office Actions, Applicant stated: “Applicant will not argue the differences in the respective services because of the rule about the ‘four corners’ [of the registration] being all that matters regarding this factor. Surely the examining attorney is aware that this ID is only this broad and ‘kitchen sink’ in nature because it is based on [Trademark Act Section] 44(e) and Applicant must of course accept that (as ‘buried’ as the description that reads on Applicant’s services is, in the registered mark).” Office Action Response of January 25, 2022, at TSDR 6.

channels or potential consumers. The third *DuPont* factor supports a finding that confusion is likely.

B. The Similarity or Dissimilarity of the Respective Marks

Under the first *DuPont* factor, we determine the similarity or dissimilarity of Applicant's and Registrant's marks in their entireties, taking into account their appearance, sound, connotation and commercial impression. *DuPont*, 177 USPQ at 567; *In re Detroit Athletic*, 128 USPQ2d at 1048. "Similarity in any one of these elements may be sufficient to find the marks confusingly similar." *In re Inn at St. John's, LLC*, 126 USPQ2d 1742, 1746 (TTAB 2018), *aff'd mem.*, 777 Fed. Appx. 516 (Fed. Cir. 2019) (quoting *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014)). We make this comparison mindful that "[w]hen trademarks would appear on substantially identical ... [services], 'the degree of similarity necessary to support a conclusion of likely confusion declines.'" *Coach Servs. Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012) (internal citations omitted).

"The proper test is not a side-by-side comparison of the marks, but instead whether the marks are sufficiently similar in terms of their commercial impression such that persons who encounter the marks would be likely to assume a connection between the parties." *In re i.am.symbolic, LLC*, 866 F.3d 1315, 123 USPQ2d 1744, 1748 (Fed. Cir. 2017) (quoting *Coach Servs.*, 101 USPQ2d at 1721 (internal quotation marks omitted)). The focus is on the recollection of the average purchaser – here a potential viewer of sports programming – who normally retains a general rather than a specific impression of trademarks. *In re Assoc. of the U.S. Army*, 85 USPQ2d 1264, 1268 (TTAB 2007); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB

1975); *see also In re St. Helena Hosp.*, 774 F.3d 747, 113 USPQ2d 1082, 1085 (Fed. Cir. 2014) (“marks must be considered in light of the fallibility of memory and not on the basis of side-by-side comparison”) (cleaned up; citation omitted).

So long as we “analyze[] the marks as a whole[, i]t is not improper for the Board to determine that, ‘for rational reasons,’ ... [we] give ‘more or less weight ... to a particular feature of the mark[s]’ provided that ... [our] ultimate conclusion regarding ... likelihood of confusion ‘rests on [a] consideration of the marks in their entirety.’” *Quiktrip W., Inc. v. Weigel Stores, Inc.*, 984 F.3d 1031, 2021 USPQ2d 35, *2-3 (Fed. Cir. 2021) (citing *Packard Press, Inc. v. Hewlett-Packard Co.*, 227 F.3d 1352, 1357 (Fed. Cir. 2000) and *In re Nat’l Data Corp.*, 753 F.2d 1056, 1058 (Fed. Cir. 1985)).

Although we must consider the marks in their entirety, we find the words “TIME OUT” to be the dominant (because it is the only) portion of Registrant’s mark, and the term “TIMEOUT” to be the dominant portion of Applicant’s TOUCHDOWN TIMEOUT mark.⁶ Applicant argues (to the contrary) that “TOUCHDOWN” is the dominant term in its TOUCHDOWN TIMEOUT mark because it appears first, citing *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005); *Century 21 Real Estate Corp. v. Century Life*

⁶ We further find no discernable distinction to consumers between TIME OUT as two words in Registrant’s mark and TIMEOUT as one word in Applicant’s mark. *See, e.g., Seaguard Cor. v. Seaward Int’l, Inc.*, 223 USPQ 48, 51 (TTAB 1984) (“‘SEAGUARD’ and ‘SEA GUARD’ are, in contemplation of law, identical”); *In re Best W. Family Steak House, Inc.*, 222 USPQ 827, 827 (TTAB 1984) (“There can be little doubt that BEEFMASTER and BEEF MASTER are practically identical”).

of America, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992); and *Presto Products Inc. v. Nice-Pak Products, Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988).⁷ While Applicant correctly recites the legal principle from these cases, “there is no mechanical test to select the dominant element of a mark.” *Tao Licensing, LLC v. Bender Consulting Ltd.*, 125 USPQ2d 1043, 1059 (TTAB 2017). While the first term in a mark generally may be considered as the feature that will be called for, and so remembered, by consumers, this is not invariably the case.

For example, as we have here, in situations where the first term in a mark functions as an adjective, descriptor or modifier of the second term, it is the subsequent term that is dominant, not the primary term. *See, e.g., Clinton Detergent Co. v. Procter & Gamble Co.*, 302 F.2d 745, 133 USPQ 520, 522 (CCPA 1962) (where the added word simply describes a use for the product (JOY vs. CARJOY detergent), it does not serve to lessen the likelihood of confusion); *Procter & Gamble Co. v. Econ. Lab’y, Inc.*, 175 USPQ 505, 510 (TTAB 1972) (Addition of “the term ‘RE’ as a prefix, signifies ‘again or anew’ and, as such, ‘REGAIN’ signifies a form of a product called ‘GAIN’ or a modified version thereof” (finding the marks GAIN vs. REGAIN for cleaning preparations likely to be confused)), *modified without op.*, 498 F.2d 1406, 181 USPQ 772 (CCPA 1974). In Applicant’s TOUCHDOWN TIMEOUT mark, we find the word “TOUCHDOWN,” a term clearly associated with American football, describes the type of television programming Applicant provides in connection with the

⁷ Applicant’s Brief, 4 TTABVUE 6.

remainder of Applicant's mark, "TIMEOUT" – interviews with football players and personalities during a break in the game.⁸

We further find that TIME OUT and TIMEOUT have a common meaning with respect to the services provided by Applicant and Registrant. The only dictionary definition of "TIME OUT" (from COLLINS online dictionary) made of record during prosecution (which was submitted by Applicant) provides:⁹

TIME OUT

1. (Variable Noun) In basketball, American football, ice hockey, and some other sports, when a team calls a time out they call a stop to the game for a few minutes in order to rest and discuss how they are going to play.
2. (Uncountable Noun) If you take time out from a job or activity, you have a break from it and do something different instead.

The second definition recited above does not apply to the respective services identified. The first definition applies to the services provided by both Applicant and Registrant.

Moreover, we find Applicant's addition of "TOUCHDOWN" to the registered TIME OUT mark does not obviate the similarity between the compared marks, nor does it overcome a likelihood of confusion under Trademark Act Section 2(d). To the contrary, Applicant's mark incorporates the cited mark in its entirety, thereby increasing the similarity between the two. *See, e.g., Coca-Cola Bottling Co. v. Jos. E. Seagram & Sons, Inc.*, 526 F.2d 556, 188 USPQ 105, 106 (CCPA 1975) (finding BENGAL and

⁸ The numerous specimens of use that Applicant made of record during prosecution support this finding. Office Action Response of June 15, 2021, at TSDR 9-23.

⁹ Definition of "TIME OUT" from COLLINS online dictionary, Office Action Response of January 25, 2022, at TSDR 14.

BENGAL LANCER and design confusingly similar); *Anheuser-Busch, LLC v. Innvopak Sys. Pty Ltd.*, 115 USPQ2d 1816, 1823 (TTAB 2015) (applicant's mark WINEBUD for "alcoholic beverages except beers" likely to cause confusion with BUD for beer); *In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266, 1269 (TTAB 2009) (finding TITAN and VANTAGE TITAN confusingly similar).

In fact, viewers of Registrant's TIME OUT television programming are likely to assume that Applicant's television programming, offered under the TOUCHDOWN TIMEOUT mark, are merely a line extension of the services emanating from Registrant. *See Joel Gott Wines, LLC v. Rehoboth Von Gott, Inc.*, 107 USPQ2d 1424, 1433 (TTAB 2013) ("Purchasers of opposer's GOTT and JOEL GOTT wines are likely to assume that applicant's goods, sold under the mark GOTT LIGHT and design, are merely a line extension of goods emanating from opposer.").

We therefore do not agree with Applicant's argument that, merely by adding the term TOUCHDOWN to the beginning of Registrant's TIME OUT mark, the TOUCHDOWN TIMEOUT and TIME OUT marks are sufficiently different in appearance, sound meaning or commercial impression so as to avoid a likelihood of confusion,¹⁰ particularly when the respective marks would be used on identical or otherwise related services. The first *DuPont* factor supports a finding that confusion is likely.

¹⁰ Applicant's Brief, 4 TTABVUE 6-7.

II. Likelihood of Confusion: Balancing the *DuPont* Factors

Based on the facts of record and arguments presented, we find Applicant's services and Registrant's identified services are legally identical in part. We therefore presume that the channels of trade and target consumers overlap. The marks TOUCHDOWN TIMEOUT and TIME OUT are more similar than they are different by the elements of appearance, sound, meaning and overall commercial impression. Confusion is therefore likely between Applicant's mark and Registrant's mark when used in connection with the respective services.

Decision:

The refusal to register Applicant's TOUCHDOWN TIMEOUT mark on the ground of likelihood of confusion pursuant to Trademark Act Section 2(d) is affirmed.